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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,409	06/30/2003	Steven M. Fischer	10010632-3	1968
22878	7590	04/17/2009	EXAMINER	
AGILENT TECHNOLOGIES INC. INTELLECTUAL PROPERTY ADMINISTRATION,LEGAL DEPT. MS BLDG. E P.O. BOX 7599 LOVELAND, CO 80537			TUNG, JOYCE	
ART UNIT	PAPER NUMBER			
			1637	
NOTIFICATION DATE	DELIVERY MODE			
04/17/2009	ELECTRONIC			

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

IPOPS.LEGAL@agilent.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/611,409	<b>Applicant(s)</b> FISCHER, STEVEN M.
	<b>Examiner</b> Joyce Tung	<b>Art Unit</b> 1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 28 January 2009.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 21-34, 42 and 43 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 21-34 and 42-43 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/136/08)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The applicant's response filed 1/28/09 to the office action has been entered. Claims 21-34 and 42-43 are pending.
2. The rejection of claims 21-34 and 42-43 under 35 U.S.C. 103(a) as being unpatentable over Schmidt et al. (WO 99/02728, issued January 21, 1999) in view of Shultz et al. (6,268,146, issued Jul. 31, 2001) is withdrawn because of the argument.

### **NEW GROUND OF REJECTION**

#### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 21-28, 31, 33-34 and 42-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Schmidt et al. (WO 99/02728, issued January 21, 1999).

Schmidt et al. disclose that in one arrangement, a series of DNA fragments is provided by contacting a template in the presence of DNA polymerase with a mixture of nucleotides sufficient for hybridizing to the template for forming a second strand of DNA complementary to the template. The mixture comprises a set of four probes containing all four nucleotides for hybridizing to the template in which the nucleotides of each probe comprise a modified nucleotide, which is capable of polymerizing to the second strand of DNA, but blocked to prevent further polymerization and which is cleavably attached to the mass label. The mass label is identified by mass spectrometry of the modified nucleotide (see pg. 3, paragraph 5 and pg. 4,

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paragraph 1). The mass label corresponds to a modified nucleotide so that the nucleotide present in the target template may be deduced (See pg. Paragraph 4). The cleavage is done by photolysis or chemical cleavage (see pg. 12, paragraph 2, pg. 13, paragraph 2, pg. 46, and paragraph 4). Ligating is also used to produce extended products (see pg. 12, paragraphs 1 and 3). The cleavable tag is a 3' cleavable tag (see pg. 46, paragraph 5, fig. 4a and fig. 13) in which the cleavable tag is attached to the 3' end.

Schmidt et al. also disclose an alternative implementation to use photolysable mass labels at the 3'-OH of each 4-mer oligonucleotide. The mass-label could be attached to another part of the molecule from which it can be released independently of the uncapping reaction of the 3' terminus (see pg. 46, paragraphs 4 and 5). This inherently teaches that 3' tag is cleaved from an extension product and not bound to said at least one complementary nucleotide and an extension product that includes said at least one complementary nucleotide hybridized to said template nucleic acid sequence.

The teachings of Schmidt et al. anticipate the limitations of the claims.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

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evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 29-30 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmidt et al. (WO 99/02728, issued January 21, 1999) as applied to claims 21-28, 31, 33-34 and 42-43 in further view of Singh (6,514,700, issued Feb. 4, 2003).

The teachings of Schmidt et al. are set forth in section 4 above. Schmidt et al. do not disclose that the cleavable tag is a fluorescent tag and it is acidic or basic cleavable.

Singh disclose a cleavable tag which is a fluorescent tag (see column 4, lines 27-30) and it is acidic or basic cleavable (see column 9, lines 9-12).

One of ordinary skill in the art would have been motivated to apply a fluorescent tag as a cleavable tag which is acidic or basic cleavable because the method of Singh is used in performing simultaneous determinations in a single container (see column 3, lines 54-55). It would have been prima facie obvious to apply a fluorescent tag as a cleavable tag for nucleic acid sequencing and it is acidic or basic cleavable.

### **Summary**

7. No claims are allowed.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joyce Tung whose telephone number is (571) 272-0790. The examiner can normally be reached on Monday - Friday, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 571 272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kenneth R Horlick/  
Primary Examiner, Art Unit 1637

/Joyce Tung/  
Examiner, Art Unit 1637  
April 4, 2009